THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte TRAVIS W. HONEYCUTT

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Appeal No. 96-2675
Application 08/299,760[1]

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ON BRIEF

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Before KIMLIN, WALTZ, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

[1] Application for patent filed September 1, 1994. According to appellants, this application is a continuation of Application 08/055,083, filed April 29, 1993, now abandoned; which is a continuation-in-part of Application 07/881,685, filed May 12, 1992, now U.S. Patent No. 5,207,837; which is a continuation-in-part of Application 07/683,290, filed April 10, 1991, now abandoned.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 of the examiner's refusal to allow claims 1 through 24 and 26 through 30, which are all of the claims on appeal.[2]

THE INVENTION

The invention is directed to a method of disposing garments and other articles prepared from polyvinyl alcohol having specific properties by dissolving the articles in warm water at temperatures above about 37EC, the body temperature. The polyvinyl alcohol has a degree of polymerization between approximately 700 and 1500, a moisture content of approximately 1.5% to 15% by weight, and contains 0.1% to 5.0% by weight of an anti-blocking agent. It is produced from at least approximately 98% saponified polyvinyl acetate. The process further requires that the moisture content of the polyvinyl alcohol polymer be reduced prior to melt extrusion and be increased subsequent to melt extrusion.

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[2] Claim 25 was canceled in an amendment dated March 30, 1994, paper No 6. Claims 31 through 59 were withdrawn from further consideration by the examiner as directed to a non-elected invention in accordance with 37 CFR § 1.142(b). See the Final Rejection dated December 8, 1994, paper No. 12.

THE CLAIMS

Claim 1 is illustrative of appellant's invention and is reproduced below.

1. A method of disposing of garments, linens, drapes, towels and other useful articles after use comprising providing said garment, linens, drapes, towels and other useful articles as a stand alone thermoplastic polymer film or fabric, which may include fiber, of polyvinyl alcohol which is water soluble at temperatures above approximately 37EC and insoluble at temperatures below approximately 37EC and subjecting said articles after use to an aqueous bath to substantially dissolve said articles whereupon said dissolved polymer is subjected to disposal, said polyvinyl alcohol polymer being produced by reducing its moisture content prior to melt extrusion and subsequent thereto, increasing its moisture content to a value between approximately 1.5 to 15.0% (wt.), said polyvinyl alcohol having a degree of polymerization between approximately 700 to 1500 being produced from at least approximately 98% saponified polyvinyl acetate and containing between approximately 0.1 to 5.0% (wt.) of an anti-blocking agent.

THE REFERENCES OF RECORD

As evidence of obviousness and double patenting, the examiner relies upon the following references.

Honeycutt 5,207,837 May 4, 1993
(Application No. 07/643,615, filed Apr. 10, 1991)

Takigawa et al. (Takigawa) 1,187,690 Apr. 15, 1970 (Great Britain)

Naude-Filonniere et al. 0 107 576 May 2, 1984[3]
(Naude-Filonniere)

THE REJECTIONS

Claims 1 through 24 and 26 through 30 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

Claims 1 through 24 and 26 through 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Takigawa in combination with Naude-Filonniere.

Claims 1 through 24 and 26 through 30 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 30 of U.S. Patent No. 5,207,837 in view of Takigawa in combination with Naude-Filonniere.

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the aforementioned rejections are not well

[3] We refer in our opinion to the translation of Naude-Filonniere of record prepared by Schreiber Translations for the U. S. Patent and Trademark Office in October 1993.

founded for essentially reasons expressed by appellant in his Brief, and we add the following primarily for emphasis. Accordingly, we will not sustain the rejections.

The Rejection under 35 U.S.C. § 103

Our view of the claimed subject matter is that it is directed to two essential limitations which are not met by the references relied upon by the examiner. The first is directed to a requirement that subsequent to the melt extrusion the moisture content of the polyvinyl alcohol be increased. The limitation of adding moisture has not been directly addressed by the examiner.

The examiner obliquely argues that appellant's argument directed to increasing the moisture content of the film after melt extrusion is unpersuasive because Takigawa discloses that any polyvinyl alcohol resin meeting specific criteria can be used, no matter how it is prepared. See Takigawa, page 2, lines 16-20. The issue however, is not how polyvinyl alcohol is prepared, even though the claim refers to a "polyvinyl alcohol polymer being produced by" increasing its moisture

content subsequent to melt extrusion. It is how polyvinyl alcohol is treated after melt extrusion of the previously prepared polymer. We find that Takigawa is directed to any polyvinyl alcohol polymer having a polymerization degree of 700 to 1500 and a hydrolysis degree of at least 97%. We further find no disclosure or suggestion in Takigawa for the addition of moisture subsequent to melt extrusion.

The second essential limitation at issue is the presence of "0.1 to 5.0% (wt.) of an anti-blocking agent." The examiner relies upon the disclosure in Naude-Filonniere for its disclosure of an anti-blocking agent. We have carefully reviewed the Naude-Filonniere reference in light of the examiner's arguments presented in the Answer (pages 4-5). On the record before us, we conclude that one of ordinary skill in the art would not go to Naude-Filonniere for the addition of an anti-blocking agent to the composition of Takigawa. We find that Naude-Filonniere is directed to a polyvinyl alcohol with delayed dissolution. We find that Naude-Filonniere buries its polyvinyl alcohol films together with its content after use as opposed to the requirement of the claimed subject matter of dissolving the polyvinyl alcohol polymer in an

aqueous bath. We further find that the polyvinyl alcohol film of Naude-Filonniere is prepared from a process substantially different from that used by Takigawa. See Takigawa, page 1, lines 23-61.

Indeed, Takigawa recognizes the difficulty of blocking using the extrusion processes of Naude-Filonniere. See page 1, lines 55-61. We find that patentee solves the blocking problem by reducing the moisture content to very low levels, and controlling the die temperature. We find the polyvinyl alcohol film of Takigawa does not exhibit any tendency to block either during or after manufacture. See page 2, lines 5-12. Accordingly, we conclude that there is no reason why one having ordinary skill in the art would have added a blocking agent to the polyvinyl alcohol composition of Takigawa.

Based upon the above analysis, we have determined that the examiner's legal conclusion of obviousness is not supported by the facts. "Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

The Double Patenting Rejection

All proper double patenting rejections rest on the fact that a patent has been issued and a later issuance of a second patent will continue protection beyond the date of expiration of the first patent of the very same invention claimed therein or of a mere variation of that invention which would have been obvious to those of ordinary skill in the relevant art. See In re Kaplan, 789 F.2d 1574, 1579-80, 229 USPQ 678, 683 (Fed. Cir. 1986).

Our analysis of the examiner's rejection of claims 1 through 24 and 26 through 30 under the doctrine of judicially created double patenting parallels that for a § 103 rejection. While the double patenting rejection is analogous to a failure to meet the non-obviousness requirement of 35 U.S.C. § 103, that section is not itself involved in double patenting rejections because the patent principally underlying the rejection is not usually prior art. In re Braat, 937 F.2d 589, 592-593, 19 USPQ2d 1289, 1292 (Fed. Cir. 1991); In re Longi, 759 F.2d 887, 892-93, 225 USPQ 645, 648 (Fed. Cir. 1985); In re Braithwaite, 379 F.2d 594, 600, n. 4, 154 USPQ 29, 34, n. 4 (CCPA 1967). When considering whether the

claimed subject matter is an obvious variation of the invention defined in the claims of the Honeycutt patent, the disclosure of the patent may not be used as prior art. Accordingly, when we focus on any variations between the Honeycutt claims and the instant claimed subject matter, our analysis parallels that in our decision under § 103 above and is incorporated herein. Therefore, for the reasons set forth above, we find that Takigawa fails to disclose or suggest the addition of moisture to the polyvinyl alcohol following melt extrusion. Similarly, for the reasons set forth above, we further find insufficient reasons for the addition of a blocking agent disclosed by Naude-Filonniere.

Moreover, the examiner has not addressed in the Answer the requirements in the claimed subject matter for, “melt extrusion” and the further requirement for, “reducing its moisture content prior to melt extrusion.” Based on the above considerations, we conclude that the claimed subject matter herein is not a mere variation of the claims in Honeycutt’s patent and would not continue protection beyond the expiration date of the Honeycutt patent. Accordingly, the examiner’s

finding of obviousness-type double patenting is not sustainable.

The Rejection Under 35 U.S.C. § 112

The legal standard for definiteness under the second paragraph of 35 U.S.C. § 112 is whether a claim reasonably apprises those of ordinary skill in the art of its scope. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The first inquiry is to determine whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity.

The examiner's position is that the phrase, "other useful articles," is indefinite and unspecified, Answer, page 3. However, breadth itself is not indefinite. In re Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970). The definiteness of the language employed must be analyzed not in a vacuum, but in light of the teachings of the particular application. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Applying the analysis set forth above, appellant's specification, page 6, discloses a substantial number of articles which fall within the scope of the phrase,

"other useful articles." One of ordinary skill in art reading the claims in light of the specification would be possessed with a reasonable degree of certainty as to the subject matter encompassed within the claims. Accordingly, the examiner has failed to establish with respect to the phrase, "other useful articles," that one of ordinary skill in the art would not be apprised of the scope of the claims containing this phrase.

As to the rejection by the examiner of the term, "dissolved polymer" as being without proper antecedent basis, Answer, page 3, we agree with appellant that the term, "thermoplastic polymer" provides sufficient antecedent basis. We further note that the examiner has not responded to appellant's argument. Accordingly, we conclude that sufficient antecedent basis for the term, "dissolved polymer," is present in the claimed subject matter.

Based on the above analysis, the rejection under § 112 is not sustained.

DECISION

The rejection of claims 1 through 24 and 26 through 30 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention is reversed.

The rejection of claims 1 through 24 and 26 through 30 under 35 U.S.C. § 103 as being unpatentable over Takigawa in combination with Naude-Filonniere is reversed.

The rejection of claims 1 through 24 and 26 through 30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 30 of U.S. Patent No. 5,207,837 in view of Takigawa in combination with Naude-Filonniere is reversed.

The decision of the examiner is reversed.

REVERSED

Edward C. Kimlin Administrative Patent Judge	)	
Thomas A. Waltz Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Paul Lieberman Administrative Patent Judge	)	

tdc

Mitchell A. Katz
NEEDLE & ROSENBERG, P.C.
Suite 1200, The Candler Building
127 Peachtree Street, N.E.
Atlanta, Georgia 30303-1811